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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,074

07/15/2003

Toru Takayama

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6973

31780

7590

12/13/2005

ERIC ROBINSON

PMB 955

21010 SOUTHBANK ST.

POTOMAC FALLS, VA 20165

EXAMINER

KEBEDE, BROOK

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,074

Applicant(s)

TAKAYAMA ET AL.

Examiner

Brook Kebede

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2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,11,15,19,23 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-10,12-14,16-18,20-22,24,25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I (i.e., claims 1, 2, 4-6, 8-10, 12-14, 16-18, 20-22 and 24-26 in the reply filed on April 18, 2005 is acknowledged.
2. Although applicants did not indicate the status of claim 27, it is considered that claim 27 reads on the elected species as being dependent of claim 4 which reads on the elected species. In addition, incorporation of claim 26 as species I is also incorrect since claim 26 is depending upon claim 3, and by virtue of dependency, claim 26 should be part of the non-elected species. Since it appears that it is a genuine error, the claims election of species I should read as 1, 2, 4-6, 8-10, 12-14, 16-18, 20-22, 24 25 and 27. This correction has been acknowledged and agreed by Mr. Eric J. Robinson, attorney for applicants, as set forth in the interview summery of June 24, 2005. (See the attached PTO-413B).
3. Accordingly, claims 3, 7, 11, 15, 19, 23 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 18, 2005.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

5. Claims 4, 17, 20, 25 and 27 are objected to because of the following informalities:

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Claim 4 recites the limitation "forming a first metal layer over **the substrate**" n line 2.

However, "the substrate" lacks proper antecedent basis. The claim can be changed to --a substrate-- in order to maintain a proper antecedent basis. Appropriate correction is required.

Claim 17, 20, 25 and 27 contain improper Markush type of group of claims. It is improper to use the term "comprising" instead of "consisting of" See *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). Appropriate correction is required.

Applicants' cooperation is requested in reviewing the claims structure to ensure proper claim construction and to correct any subsequently discovered instances of claim language noncompliance. See *Morton International Inc.*, 28USPQ2d 1190, 1195 (CAFC, 1993).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 4-6, 8-10, 12-14, 16-18, 20-22 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/740,437. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

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Re claims 1, 2, 4-6, 8-10, 12-14, 16-18, 20-22 and 24, the subject matter claimed invention of the instant application is similar to that of the co-pending U.S. Application No. 10/740,437 and the scope the instant application and that of Application No. 10/740,437 are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 25 and 27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/740,437, as applied in Paragraph 6 above, and further in view of Inoue et al. (US/6,127,199).

Re claims 25 and 27, as applied in claims 2 and 4 respectively in Paragraph 6 above, the scope of claimed subject matter of the instant application and that of Application No. 10/740,437 is similar except the device elements that recited in claims 25 and 27.

Inoue et al. (US/6,127,199) disclose a peeling method that includes the device element such as liquid crystal display in order to fabricate the semiconductor device by device transfer method (see Inoue et al. Col. 8, line 45- Col. 22, line 50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant(s) claimed invention was made to provide Application No. 10/740,437 with an element provided on insulating layer which consisting of a light emitting, a semiconductor or a liquid crystal element as taught by Inoue et al. in order to fabricate the semiconductor device (i.e., active matrix device) by device transfer method.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

9. Applicants' arguments filed on September 30, 2005 have been fully considered but they are not persuasive.

With respect to provisional double patenting rejection of the instant application with the copending application 10/740,437, Applicants argue that the rejection should be withdrawn in the instant application because the only outstanding rejection is a provisional double-patenting so that the rejection of the instant application should have been withdrawn according the guidance that set forth in MPEP § 804.

In response to Applicants' argument, it is respectfully submitted that in the 10/740,437 application the instant application is not used to reject the copending claims. If the instant application, i.e., 10/619,074, is used to reject the copending 10/740,437 application and the same time the copending application, i.e., 10/740,437 is used to reject the instant application, the rejection of provisional double patenting would have been withdrawn according guidance as set forth in MPEP § 804 in order to allow the instant application to mature to patent while keeping double patenting rejection in 10/740,437 over the instant application (i.e., 10/619,074). However, the provisional-double patenting rejection in 10/740,437 application is made over another copending U.S. application, i.e., 10/740,501.

Hence, the rejection of the instant application cannot be withdrawn because the guideline that is set forth MPEP § 804 is not applicable for the reasons explained above. Therefore, provisional double-patenting rejection is still deemed proper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brook Kebede whose telephone number is (571) 272-1862. The examiner can normally be reached on 8-5 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brook Kebede
Primary Examiner
Art Unit 2823

BK
June 24, 2005